

ESTTA Tracking number: **ESTTA1268**

Filing date: **06/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203277
Party	Defendant Palm Beach Motoring Accessories, Inc.
Correspondence Address	LEO ZUCKER LAW OFFICE OF LEO ZUCKER 2591 DUNNING DRIVE, PO BOX 1177 YORKTOWN HEIGHTS, NY 10598-8177 UNITED STATES lzpatents@gmail.com
Submission	Opposition/Response to Motion
Filer's Name	Leo Zucker
Filer's e-mail	lzpatents@gmail.com
Signature	/Leo Zucker/
Date	06/11/2013
Attachments	Brief.pdf(33437 bytes) lz.pdf(37597 bytes) Exh_A.pdf(11621 bytes) Exh_B.pdf(20672 bytes) Exh_C.pdf(15432 bytes) Exh_D.pdf(13405 bytes) Exh_E.pdf(18144 bytes) Exh_F.pdf(19323 bytes) Exh_G.pdf(19344 bytes) Exh_H.pdf(11979 bytes) Exh_I.pdf(14400 bytes) Exh_J.pdf(18572 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board

3D International, LLC,)
a California Limited Liability Company,)

Opposer,)

V.

Palm Beach Motoring Accessories, Inc.,)
a Florida Corporation,)

Applicant.)

Opposition Nos. **91203277** (parent)
91203279

Application No. 85-261,047
Mark: AUTOPIA FORUM, in Class 38

Application No. 85-312,684
Mark: AUTOPIAFORUMS, in Class 38

**APPLICANT’S BRIEF IN OPPOSITION TO OPPOSER’S MOTION TO COMPEL
DISCOVERY RESPONSES, TO RESET DISCOVERY AND TRIAL, AND FOR
SANCTIONS**

TO: Trademark Trial & Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,
Thomas Cook Intellectual Properties
3030 Bridgeway, Suite 425
Sausalito, CA 94965

Law Office of Leo Zucker
Attorney for Applicant
2591 Dunning Drive
P.O. Box 1177
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

June 11, 2013

INTRODUCTION

Applicant (PBMA) respectfully submits this brief, and an accompanying Declaration of Leo Zucker with Exhibits in opposition to the motion filed May 27, 2013, by Opposer 3D International, LLC (3D) to compel discovery responses, to reset discovery and trial dates, and for sanctions.

ARGUMENT

The accompanying Declaration and Exhibits demonstrate that 3D's motion should be denied. Specifically, at the time 3D filed the motion and pursuant to agreement between counsel, 3D had *received* the bulk of its requested discovery and knew that the remaining responses were imminent.

The chronology of 3D's discovery requests and PBMA's responses is set out in detail in the accompanying Declaration of PBMA's attorney, and shown by Exhibits A to J annexed to the Declaration.

In its motion, 3D admits that on May 20 and 23, 2013, *i.e.*, at least four days before it filed the motion, 3D had received all of PBMA's responses to 3D's First

and Second Sets of Requests for Admissions.¹ 3D also knew by an agreement between counsel that when 3D received the responses, PBMA was then preparing responses to 3D's First and Second Sets of Interrogatories and Document Requests, and that service of those responses on 3D was imminent.² Just two days after filing the present motion, on May 29, 2013, 3D thanked PBMA for the responses to 3D's interrogatories and document requests.³ Yet, to date, 3D has failed to inform the Board pursuant to 37 C.F.R. §§ 2.120 (e)(1) & (h)(1) that *all* the responses sought to be compelled were in fact received, thus rendering this motion moot.⁴

In support of its motion, 3D argues that "Opposer [*sic*] has said nothing about when such responses will be returned."⁵ The statement is untrue in light of PBMA's notice to 3D on May 13, 2013, which 3D acknowledged "with thanks" on the same day.⁶ Accordingly, in view of 3D's conduct in bringing this motion to compel in the first instance, and then failing to advise the Board of 3D's receipt of all the sought responses, appropriate sanctions should be imposed on 3D rather than on PBMA for

¹ Opposer's Motion, page 5, par. 19.

² Zucker Declaration, pars. 11-14 and Exh. H.

³ Zucker Declaration, par. 15 and Exh. J.

⁴ *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987).

⁵ Opposer's Motion, page 6, par. 22.

⁶ Exhibit H.

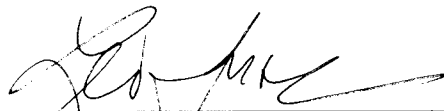
making PBMA incur the cost and expense of having to respond to this motion.

Moreover, the request by 3D to reschedule discovery and trial in this proceeding⁷ omits any date by which PBMA's Answers to 3D's Amended Notices of Opposition filed May 3, 2013, are to be served. PBMA therefore respectfully requests that the discovery and trial schedule be reset taking into account PBMA's obligation to file Amended Answers, and PBMA's right to obtain discovery relating to all the allegations in the Amended Notices.

CONCLUSION

In view of all the foregoing, 3D's present motion to compel discovery responses, and for sanctions, should be denied.

Respectfully submitted,



Leo Zucker, Attorney for Applicant
Palm Beach Motoring Accessories, Inc.

June 11, 2013

⁷ Opposer's Motion, page 7, par. 4.

CERTIFICATE OF SERVICE

I hereby certify that the within APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES, TO RESET DISCOVERY AND TRIAL, AND FOR SANCTIONS, and the accompanying Declaration of Leo Zucker with Exhibits A to , were served upon Opposer 3D International, LLC, by depositing same with the U.S. Postal Service as first class mail in a sealed envelope, postage prepaid, and addressed to:

Thomas W. Cook, Esq.,
Thomas Cook Intellectual Properties
3030 Bridgeway, Suite 425
Sausalito, CA 94965

on June 11, 2013.

A handwritten signature in black ink, appearing to read "Leo Zucker", written over a horizontal line.

Leo Zucker, Attorney for Applicant
Palm Beach Motoring Accessories, Inc.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board

3D International, LLC,)
a California Limited Liability Company,)
)
Opposer,)
)
v.)
)
Palm Beach Motoring Accessories, Inc.,)
a Florida Corporation,)
)
Applicant.)

Opposition Nos. **91203277 (parent)**
91203279

Application No. 85-261,047
Mark: AUTOPIA FORUM, in Class 38

Application No. 85-312,684
Mark: AUTOPIAFORUMS, in Class 38

**DECLARATION OF LEO ZUCKER AND EXHIBITS IN OPPOSITION TO OPPOSER'S
MOTION TO COMPEL DISCOVERY RESPONSES, TO RESET DISCOVERY AND
TRIAL, AND FOR SANCTIONS**

TO: Trademark Trial & Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Thomas W. Cook, Esq.,
Thomas Cook Intellectual Properties
3030 Bridgeway, Suite 425
Sausalito, CA 94965

Law Office of Leo Zucker
Attorney for Applicant
2591 Dunning Drive
P.O. Box 1177
Yorktown Heights, NY 10598

Telephone: (914) 302-2460

June 11, 2013

LEO ZUCKER, hereby deposes and states:

1. I am over 18 years of age, and I am an attorney at law licensed to practice in the courts of the State of New York and before the United States Patent and Trademark Office.

2. I represent the Applicant, Palm Beach Motoring Accessories, Inc. (PBMA) in the present opposition proceeding, and I have personal knowledge of all matters set forth herein.

3. Exhibit A, attached, is an e-mail from 3D's attorney dated August 27, 2012, agreeing to my request to extend by 30 days PBMA's time to respond to 3D's First Set of 3D's Requests for Admissions, Interrogatories, and Requests for Documents. I e-mailed the request to 3D's attorney earlier the same day as shown in the thread below 3D's e-mail, for the reasons I stated and with the understanding that PBMA's responses would then be due 30 days from September 15, 2012, *i.e.*, by October 15, 2012 (a Monday).

4. Exhibit B is an e-mail from 3D's attorney dated October 6, 2012, responding to settlement terms that PBMA proposed by e-mail on July 30, and attaching copies of 3D's Second Set of Requests for Admissions, Interrogatories, and

Requests for Documents.

5. Believing that based on evidence available to PBMA at the time, there was no genuine dispute as to any material fact concerning PBMA's right to register the presently opposed marks, and in the interest of judicial economy, PBMA filed a Motion for Summary Judgment (MSJ) on October 15, 2012. It was and remains my belief that the filing of the motion served to suspend the proceedings including PBMA's obligation to respond to 3D's outstanding discovery requests.¹

6. 3D requested PBMA to consent to a motion for a 30-day extension for 3D to file an Answer to the MSJ, *i.e.*, until December 17, 2012, and PBMA agreed. See the e-mails on Exhibit C. Without seeking to compel responses to its outstanding requests or any further discovery under Rule 56(d), Fed. R. Civ. P., 3D filed its Answer on December 17.

7. While a Board decision on the MSJ was pending, 3D's attorney inquired more than once as to the status of its outstanding discovery requests. I responded each time by restating my belief that responses to 3D's discovery requests were not due prior to filing the MSJ or while the motion was pending, and that the Board

¹ 37 C.F.R. § 2.127(d), as clarified in *Benedict v. Super Bakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1092 (Fed. Cir. 2011).

would reset the date for PBMA to respond to those requests if the motion is denied.

See our e-mail exchanges on Exhibits D and E.

8. By Order of the Board dated April 16, 2013, the MSJ was denied. The dates for discovery and trial were reset,² but no due date was set specifically for outstanding discovery requests.

9. In view of the fact that the parties had been exchanging offers and counteroffers for a settlement up to the time 3D filed its Answer to the MSJ, I suggested to 3D that we file a consent motion to suspend the proceeding for at least one month pending settlement, and that if the parties cannot achieve a satisfactory resolution during the suspension, the discovery period would be reset and PBMA would then respond to 3D's outstanding requests. See Exhibit F.

10. By its e-mail dated May 6, 2013 (Exhibit G), 3D proposed to reset the trial schedule rather than move for a suspension, including allowing PBMA one month to respond to the outstanding requests. Exhibit G, page 1, par. B.

11. While considering the terms of 3D's proposal, PBMA notified 3D on

² Order, at 10-11.

May 13 that PBMA was in the process of responding to all of 3D's outstanding requests, that PBMA would forward the responses to 3D as each set was completed, and that PBMA would reply to the remaining items raised in 3D's e-mail of May 6 after all the responses were served. 3D acknowledged receipt of my May 13 e-mail "with thanks." See Exhibit H.


12. Notwithstanding 3D's First and Second Sets of Requests for Admissions comprised 182 such requests and many of them took much valuable time on the part of PBMA personnel to consider and respond, all the responses were completed and served on 3D on May 17, 2013.

13. After serving the responses to 3D's First and Second Sets of Requests for Admissions, PBMA proceeded promptly to formulate responses to 3D's First and Second Sets of Interrogatories and Requests for Documents. All the responses were completed and served on 3D on May 28, 2013.

14. By e-mail dated May 27, 2013, 3D's attorney *acknowledged receipt* of PBMA's responses to 3D's Requests for Admissions, but nonetheless attached 3D's present Motion to Compel Discovery "in light of Opposer's time limitations, and the delay in receiving these responses, and the responses which we have not yet received." See Exhibit I.

15. Further, by e-mail dated May 29 (Exhibit J), 3D's attorney thanked me for PBMA's responses to 3D's First and Second Sets of Interrogatories and Document Requests.

16. I further declare that all statements made of my own knowledge are true, and all statements made on information and belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the opposed applications or documents or any registrations resulting therefrom.



Leo Zucker

June 11, 2013

Leo Zucker

From: Thomas Cook [tom@thomascooklaw.com]
Sent: Monday, August 27, 2012 6:24 PM
To: Leo Zucker
Subject: Re: 3D v. PBMA TM Oppositions - 3D's First Set of Discovery Requests

Leo:

It is reasonable to stipulate to a 30-day extension for PBMA to respond to 3D's discovery requests of August 11, 2012, and also reasonable to stipulate to a corresponding (second) extension in the discovery and trial schedule. May we agree to both?

I am also mindful that we owe PBMA a settlement proposal, which has been delayed somewhat. However, we will be back shortly with that proposal as well.

Best regards,

Thomas.

-

--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

On 8/27/2012 2:45 PM, Leo Zucker wrote:

>

> Thomas,

>

> Would you please stipulate to a 30-day extension for PBMA to respond
> to the above discovery requests sent by US mail postmarked August 11,
> 2012. Due to the number of requests, the fact that I'll be away from
> the office from August 28 to Sept 6, and the client's own
> availability, it is unlikely that full responses will be ready to be served by Sept 15.

>

> Thank you for your consideration.

>

> Best regards,

>

> Leo

>

> /Law Office of Leo Zucker /

>

> /Patent & Trademark Law /

>

> PO Box 1177

>

> Yorktown Heights, NY 10598

>

> Tel (914) 302-2460

>

> Fax (914) 302-2459

>

> /This e-mail and any attached files or items are proprietary and

Leo Zucker

From: Thomas Cook [tom@thomascooklaw.com]
Sent: Saturday, October 06, 2012 5:13 PM
To: Leo Zucker
Subject: 3D v. PBMA TM Oppositions
Attachments: 2010 10 03 Opposer's Request for Production, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf; 2010 10 03 Opposer's Interrogatories, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf; 2010 10 03 Opposer's Request for Admission, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf

Leo:

We are still working on a counter-proposal, and will be back to you with that shortly.

In the meantime, I attach copies of our recent additional discovery requests (Set Number Two).

Thomas.

-

--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

.

On 7/31/2012 4:51 PM, Thomas Cook wrote:

> Leo:

>

> Received, with thanks, and back shortly.

>

> Thomas.

> -

> --

> ---

> *Thomas Cook Intellectual Property Attorneys* P.O. Box 1989, 3030

> Bridgeway, Suite 425-430 Sausalito, California 94965-1989

> Telephone: 415-339-8550

> On 7/30/2012 11:47 AM, Leo Zucker wrote:

>>

>> Dear Thomas:

>>

>> Here are terms that PBMA proposes concerning a possible settlement of

>> the above oppositions, most of which were discussed during our June

>> 26 phone conference. We did not yet receive the outline mentioned in item 2 of your June 26 email, below.

>>

>> 1. PBMA will not oppose or contest 3D's right to use and register

>> AUTOPIA.ORG for online forums for user comments and discussions relating to automobile detailing.

>>

>> 2. (a) PBMA will include an express disclaimer in the legal notices

>> section of its AUTOPIAFORUMS or AUTOPIA FORUM website, stating that

EXHIBIT B

1/2

>> PBMA is not affiliated with or sponsored by 3D, or with the AUTOPIA.ORG website currently owned and operated by 3D.
>>
>> (b) 3D will include an express disclaimer in the legal notices
>> section of its AUTOPIA.ORG website, stating that 3D is not affiliated
>> with or sponsored by PBMA, or with the AUTOPIAFORUMS or AUTOPIA FORUM websites currently owned and operated by PBMA.
>>
>> 3. The moderators of each of the parties' online forums will be
>> obliged to control user discussions conducted on either party's forum
>> so as not to permit any user to disparage, discredit, or otherwise
>> defame the other party's online forum, the owner or operator of the
>> other party's forum (i.e., either 3D or PBMA, their agents or employees), or any products that are promoted or sold via the other party's forum.
>>
>> 4. 3D will not oppose or contest PBMA's right to use and register
>> AUTOPIA CAR CARE as a trademark with respect to the detailing,
>> cleaning, or polishing of motor vehicles, or any related products.
>>
>> 5. The parties will execute a Stipulation and Consent to a Dismissal
>> of both opposition proceedings with prejudice, in view of a written
>> settlement agreement that will be designated Confidential and not
>> disclosed by either party to any third parties including users of the
>> parties' forums, or to any trade publications whether print or online.
>>
>> We look forward to your response. Best regards,
>>
>> Leo
>>
>> -----Original Message-----
>> From: Thomas Cook [<mailto:tom@thomascooklaw.com>]
>> Sent: Tuesday, June 26, 2012 6:15 PM
>> To: Leo Zucker
>> Subject: Re: 3D v. PBMA TM Oppositions - phone conference
>>
>> Dear Leo:
>>
>> Thank you for being available for our 37 CFR § 2.120(a)(2) phone "discovery conference"
>>
>> today. As we left it:
>>
>> 1. The parties have at least expressed an interest in settling these cases. We have
>>
>> informally explored some possible arrangements, and will now each
>> take our exchange back to our clients for consideration.
>>
>> 2. Since I think there is benefit in briefly outlining any settlement proposal, I will
>>
>> shortly forward an outline of our thoughts on a proposed settlement
>> arrangement. I understand you will do the same.
>>
>> 3. While we wish to avoid unnecessary activity as we discuss possible settlement, you
>>
>> can appreciate that our burden and time constraints in these cases
>> makes some early discovery desirable. I will therefore shortly
>> forward our first round of discovery requests.

EXH.B²/2

Leo Zucker

From: Leo Zucker [lzpatents@gmail.com]
Sent: Thursday, November 08, 2012 3:09 PM
To: 'tom@thomascooklaw.com'
Subject: 3D v. PBMA TM Oppositions

OK Thomas.

Regards, Leo

-----Original Message-----

From: Thomas Cook [mailto:tom@thomascooklaw.com]
Sent: Thursday, November 08, 2012 2:54 PM
To: Leo Zucker
Subject: Re: 3D v. PBMA TM Oppositions

Dear Leo:

Many thanks for confirming PBMA's consent to additional time to respond to the Motion. We agree the new term for response ends December 17, 2012. I will file for approval of the TTAB, and advise.

We will get back to you about the proposals of 3D and PBMA as soon as possible.

Regards,

Thomas.

-

--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

On 11/8/2012 9:44 AM, Leo Zucker wrote:

>
> Dear Thomas,
>
> PBMA will consent to one 30-day extension for 3D to file an opposing
> brief on the pending motion. Per my calculations, the present term for
> filing the brief expires November 17, 2012 (/i.e. /30 days from Oct
> 18, which is five days from the date the motion was served by mail on Oct 13).
>
> A 30-day extension will therefore extend the term for 3D to file its
> brief to December 17. Considering that the parties had arrived at
> substantially the same terms set out in the present counterproposal
> when they met recently at the SEMA show, there is no reason why this matter should not be satisfactorily
concluded well before Dec 17.
>
> Thank you for your cooperation. Best regards,

EXHIBIT C

1/2

>
> Leo
>
> /Law Office of Leo Zucker /
>
> /Patent & Trademark Law /
>
> PO Box 1177
>
> Yorktown Heights, NY 10598
>
> Tel (914) 302-2460
>
> Fax (914) 302-2459
>
> /This e-mail and any attached files or items are proprietary and
> subject to attorney-client or work product privileges. The use or
> disclosure of this communication by anyone other than a designated
> addressee is unauthorized. If you are not an intended recipient,
> kindly notify the sender by reply e-mail, and destroy this
> communication and any copies thereof in your possession. /
>

EMC 2/2

Leo Zucker

From: Leo Zucker [lzpatents@gmail.com]
Sent: Wednesday, December 19, 2012 10:30 AM
To: 'tom@thomascooklaw.com'
Subject: 3D v. PBMA TM Oppositions

Thomas,

Thank you for 3D's counterproposal for settlement and copy of 3D's response to the pending sj motion. We will respond to both in due course. Concerning the status of discovery, I believe discovery has been suspended in view of the motion, and that the Board will reset the time for PBMA to respond to all outstanding discovery requests should the Board deny the motion. See 37 C.F.R. 2.127(d) and the Board's Suspension Order.

Regards,

Leo

Law Office of Leo Zucker
Patent & Trademark Law
PO Box 1177
Yorktown Heights, NY 10598

Tel (914) 302-2460
Fax (914) 302-2459

This e-mail and any attached files or items are proprietary and subject to attorney-client or work product privileges. The use or disclosure of this communication by anyone other than a designated addressee is unauthorized. If you are not an intended recipient, kindly notify the sender by reply e-mail, and destroy this communication and any copies thereof in your possession.

-----Original Message-----

From: Thomas Cook [mailto:tom@thomascooklaw.com]
Sent: Monday, December 17, 2012 8:59 PM
To: Leo Zucker
Subject: Re: 3D v. PBMA TM Oppositions

Leo:

Please find 3D's response to PBMA's proposal attached, a request for status regarding discovery, and a complimentary copy of its response to PBMA's Motion for Summary Judgment (with Declaration of Goren).

Regards,

Thomas.

-
--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

Leo Zucker

From: Leo Zucker [lzpatents@gmail.com]
Sent: Monday, January 21, 2013 6:19 PM
To: 'tom@thomascooklaw.com'
Subject: 3D v. PBMA TM Oppositions

Thomas,

In reply to your question below; "[I]s PBMA ... refusing to respond to 3D's discovery, which was served and due for response *prior* to the filing of PBMA's Motion for Summary Judgment?" (emphasis added) -

As we explained on at least two prior occasions, 3D's discovery was not due for response "prior" to filing of PBMA's motion for summary judgment. And again, if the pending SJ motion is denied, the Board will reset the date for responding to outstanding discovery requests, and then PBMA will respond or otherwise move timely with respect to 3D's outstanding requests.

Concerning 3D's settlement terms proposed Dec 17, and in the interest of judicial economy, PBMA has decided to wait for the Board's decision on the pending SJ motion rather than to continue with settlement offers/counteroffers at this time.

Best regards,
Leo

Law Office of Leo Zucker
Patent & Trademark Law
PO Box 1177
Yorktown Heights, NY 10598

Tel (914) 302-2460
Fax (914) 302-2459

This e-mail and any attached files or items are proprietary and subject to attorney-client or work product privileges. The use or disclosure of this communication by anyone other than a designated addressee is unauthorized. If you are not an intended recipient, kindly notify the sender by reply e-mail, and destroy this communication and any copies thereof in your possession.

-----Original Message-----

From: Thomas Cook [mailto:tom@thomascooklaw.com]
Sent: Monday, January 21, 2013 5:54 PM
To: Leo Zucker
Subject: Re: 3D v. PBMA TM Oppositions

Leo:

May I have PBMA's response to our enquiry? Please advise.

Thomas.

-
--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

EXHIBIT E



On 1/15/2013 10:32 AM, Thomas Cook wrote:

> Leo:

>

> While preparing discovery responses make take additional time, we

> think the question I asked December 22, 2012, renewed January 7, 2013,

> can be answered without significant delay. Repeating that question

> here, is PBMA is refusing to respond to 3D's discovery, which was

> served and due for response prior to the filing of PBMA's Motion for Summary Judgment?

>

> Best regards,

>

> Thomas.

> -

> --

> ---

> *Thomas Cook Intellectual Property Attorneys* P.O. Box 1989, 3030

> Bridgeway, Suite 425-430 Sausalito, California 94965-1989

> Telephone: 415-339-8550

Leo Zucker

From: Leo Zucker [lzpatents@gmail.com]
Sent: Monday, April 29, 2013 6:08 PM
To: 'tom@thomascooklaw.com'
Subject: 3D International LLC v. Palm Beach Motoring Accessories, Inc.

Thomas,

Considering that the parties had been converging toward a workable settlement in this proceeding, and PBMA is prepared to respond to 3D's last proposal which was offered when 3D filed its Answer to the SJ motion, I suggest that we file a motion on consent to suspend the proceeding through May 31 pending final settlement. Should the parties be unable to achieve a satisfactory resolution during this period (or any extensions on consent), the discovery period will be reset accordingly and PBMA will respond to 3D's outstanding requests.

Thank you for your consideration.

Leo

Law Office of Leo Zucker
Patent & Trademark Law
PO Box 1177
Yorktown Heights, NY 10598

Tel (914) 302-2460
Fax (914) 302-2459

This e-mail and any attached files or items are proprietary and subject to attorney-client or work product privileges. The use or disclosure of this communication by anyone other than a designated addressee is unauthorized. If you are not an intended recipient, kindly notify the sender by reply e-mail, and destroy this communication and any copies thereof in your possession.

-----Original Message-----

From: Thomas Cook [mailto:tom@thomascooklaw.com]
Sent: Thursday, April 18, 2013 3:20 PM
To: Leo Zucker
Subject: Re: 3D International LLC v. Palm Beach Motoring Accessories, Inc. - Outstanding Discovery Responses

Received, with thanks,

Thomas.

-
--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

On 4/17/2013 5:10 PM, Leo Zucker wrote:

> Thomas,
>
> We are currently reviewing the decision, and will contact you shortly
> concerning the outstanding requests.
>
> Best regards,
> Leo
>
> Law Office of Leo Zucker
> Patent & Trademark Law
> PO Box 1177
> Yorktown Heights, NY 10598
>
> Tel (914) 302-2460
> Fax (914) 302-2459
>
> This e-mail and any attached files or items are proprietary and
> subject to attorney-client or work product privileges. The use or
> disclosure of this communication by anyone other than a designated addressee is unauthorized.
> If you are not an intended recipient, kindly notify the sender by
> reply e-mail, and destroy this communication and any copies thereof in
> your possession.

>
>
>
> -----Original Message-----
> From: Thomas Cook [mailto:tclaws@pacbell.net]
> Sent: Wednesday, April 17, 2013 7:31 PM
> To: Leo Zucker
> Subject: Re: Opposition - 91203277 (Parent) - 3D International LLC v.
> Palm Beach Motoring Accessories, Inc. - 85261047 - Outstanding
> Discovery Responses Overdue

>
> Leo:
>
> I see we have received an order on PBMA's Motion for Summary Judgment.
> Please advise when might we expect responses to our discovery served
> August
> 10 and October 2, 2012?

>
> Regards,
>
> Thomas.

>
> -
> --
> ---
> Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030
> Bridgeway, Suite 425-430 Sausalito, California 94965-1989 United
> States of America
> Telephone: 415-339-8550
> tom@thomascooklaw.com

>
>

EXH. F 2/2

Leo Zucker

From: Thomas Cook [tclaws@pacbell.net]
Sent: Monday, May 06, 2013 4:22 PM
To: Leo Zucker
Subject: Re: 3D International LLC v. Palm Beach Motoring Accessories, Inc.

Leo:

We may in fact be converging toward a workable settlement, as you say. We did, after all, at least begin the process of discussion with:

1. PBMA's Proposal of July 30, 2012.
2. 3D's Proposal of October 15, 2012 (Nine Points).
3. PBMA's Proposal of November 6, 2012.
4. 3D's Proposal of December 17, 2012.

However, the pace of negotiation appears to have slowed. The last communication we had on the subject of settlement was 3D's proposal of December 17, 2012. We did not receive any response from PBMA then, so we followed up with another email January 7, 2013. Again no response.

We are happy that PBMA is prepared to respond to that proposal now. However, as I said April 29, we think the Board's order anticipates discovery (and responses) will have continued while PBMA's Motion was pending. If the Board now suspends, it will reset after suspension with that same assumption. We therefore suggest an arrangement which will, in essence, take this case back to the point where PBMA's filed its motion. Given the the 4+ month delay, and given our diverging views on responses to discovery, we suggest 3D and PBMA agree:

- A. PBMA and 3D will reset the trial schedule, not suspend it, to recoup the time 3D has lost while PBMA has delayed its responses to discovery after 3D's first set of discovery was served August 10, 2012. With the one month extension granted for that set of discovery, I calculate we can reset the present discovery and trial schedule back seven months. I will draft a request for approval by the Board if PBMA agrees.
- B. PBMA will respond to outstanding discovery within one month, but PBMA may serve its own discovery only one month after 3D has received its responses to outstanding discovery.
- C. PBMA and 3D will always respond to discovery within one month, regardless of any further motions which may be filed, unless otherwise agreed.
- D. PBMA and 3D will suspend this case to continue negotiations, after the Board agrees to the trial reset set forth above ("A"), and after we receive a response to our December 17 proposal and responses to our outstanding discovery.

Please let us know if this arrangement is acceptable.

Thomas.

-
--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito,
California 94965-1989 United States of America
Telephone: 415-339-8550

On 4/30/2013 12:44 PM, Thomas Cook wrote:

> Leo:

>

> Received, and back shortly.

>

> Thomas.

> -

> --

> ---

> *Thomas Cook Intellectual Property Attorneys* P.O. Box 1989, 3030

> Bridgeway, Suite 425-430 Sausalito, California 94965-1989

> Telephone: 415-339-8550

>

>

>

>

>

> On 4/29/2013 3:07 PM, Leo Zucker wrote:

>>

>> Thomas,

>>

>> Considering that the parties had been converging toward a workable

>> settlement in this proceeding, and PBMA is prepared to respond to

>> 3D's last proposal which was offered when 3D filed its Answer to the

>> SJ motion, I suggest that we file a motion on consent to suspend the

>> proceeding through May 31 pending final settlement. Should the

>> parties be unable to achieve a satisfactory resolution during this

>> period (or any extensions on consent), the discovery period will be reset accordingly and PBMA will respond to 3D's outstanding requests.

>>

>> Thank you for your consideration.

>>

>> Leo

>>

>> /Law Office of Leo Zucker /

>>

>> /Patent & Trademark Law /

>>

>> PO Box 1177

>>

>> Yorktown Heights, NY 10598

>>

>> Tel (914) 302-2460

>>

>> Fax (914) 302-2459

>>

>> /This e-mail and any attached files or items are proprietary and

>> subject to attorney-client or work product privileges. The use or

>> disclosure of this communication by anyone other than a designated

>> addressee is unauthorized. If you are not an intended recipient,

>> kindly notify the sender by reply e-mail, and destroy this

>> communication and any copies thereof in your possession. /

>>

EXH. G 2/2

Leo Zucker

From: Thomas Cook [tom@thomascooklaw.com]
Sent: Monday, May 13, 2013 12:55 PM
To: Leo Zucker
Cc: Thomas Cook
Subject: Re: 3D International LLC v. Palm Beach Motoring Accessories, Inc.

Received. with thanks.

On May 13, 2013, at 8:28 AM, "Leo Zucker" <lzpatents@gmail.com> wrote:

Thomas,

We are in the process of responding to 3D's outstanding discovery requests, and I will send PBMA's responses to you as each set is completed.

I expect all of the responses will be completed and forwarded to you by the middle of next week, at which time we will also reply to the remaining items raised in your e-mail of May 6, below.

Regards,

Leo

Law Office of Leo Zucker

Patent & Trademark Law

PO Box 1177

Yorktown Heights, NY 10598

Tel (914) 302-2460

Fax (914) 302-2459

Leo Zucker

From: Thomas Cook [tom@thomascooklaw.com]
Sent: Monday, May 27, 2013 7:12 PM
To: Leo Zucker
Subject: Re: 3D International LLC v. Palm Beach Motoring Accessories, Inc.
Attachments: Motion to Compel Discovery & Sanctions.pdf; Exhibit A - 2012 08 10 Opposer's RFPOD, Set One - AUTOPIA FORUM - As Served.pdf; Exhibit A - 2012 08 10 Opposer's Interrogatories, Set One - AUTOPIA FORUM - As Served.pdf; Exhibit A - 2012 08 10 Opposer's RFA, Set One - AUTOPIA FORUM - As Served.pdf; Exhibit B - 2012 10 03 Opposer's Request for Production, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf; Exhibit B - 2012 10 03 Opposer's Interrogatories, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf; Exhibit B - 2012 10 03 Opposer's Request for Admission, Set Two, AUTOPIA FORUM & AUTOPIAFORUMS - 91203277 & 91203279.pdf; Exhibit C - 2012 12 17 Email to Applicant's Attorney.pdf; Exhibit D - 2012 12 19 Email from Applicant's Attorney.pdf; Exhibit E - 2012 12 19 Email to Applicant's Attorney.pdf; Exhibit F - 2012 12 21 Email from Applicant's Attorney.pdf; Exhibit G - 2012 12 22 Email to Applicant's Attorney.pdf; Exhibit H - 2013 01 07 Email to Applicant's Attorney.pdf; Exhibit I - 2013 01 15 Email to Applicant's Attorney.pdf; Exhibit J - 2013 01 21 Email to Applicant's Attorney.pdf; Exhibit L - 2013 04 17 Email to Applicant's Attorney.pdf; Exhibit M - 2013 04 17 Email from Applicant's Attorney.pdf; Exhibit N - 2013 04 29 Email to Applicant's Attorney.pdf; Exhibit O - 2013 04 29 Email from Applicant's Attorney-.pdf; Exhibit P - 2013 05 06 Email from Applicant's Attorney.pdf

Leo:

We have received PBMA's responses to our Requests for Admissions. However, in light of Opposer's time limitations, and the delay in receiving these responses, and the responses which we have not yet received, I attach a copy of:

OPPOSER'S MOTION TO COMPEL RESPONSES TO:

1. OPPOSER'S REQUESTS FOR ADMISSIONS, SETS ONE & TWO 2. OPPOSER'S INTERROGATORIES, SETS ONE & TWO 3. OPPOSER'S REQUESTS FOR DOCUMENTS, SETS ONE & TWO AND OPPOSER'S REQUEST TO RESET DISCOVERY AND TRIAL, AND FOR SANCTIONS

Regards,

Thomas.

-

--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

On 5/13/2013 9:54 AM, Thomas Cook wrote:

> Received, with thanks.

>

>

>

> On May 13, 2013, at 8:28 AM, "Leo Zucker" <lzpatents@gmail.com

> <mailto:lzpatents@gmail.com>> wrote:

EXHIBIT I

Leo Zucker

From: Thomas Cook [tom@thomascooklaw.com]
Sent: Wednesday, May 29, 2013 2:42 PM
To: Leo Zucker
Subject: Re: 3D International LLC v. Palm Beach Motoring Accessories, Inc.
Attachments: 2012 12 17 LT Zucker - Proposal.pdf

Leo:

Thank you for PBMA's responses to 3D's First and Second Sets of Interrogatories and Documents Requests. We will look for the "hard copies" by post, and we will let you know of our questions or comments to those responses.

We understand PBMA will not agree to any of the terms set forth in our proposal for discovery and trial dates set forth in my email dated May 6, 2013.

However, we also recall from your April 29, 2013, email that "...PBMA is prepared to respond to 3D's last proposal which was offered when 3D filed its Answer to the SJ motion..."). We understand from this that PBMA is still considering 3D's December 17, 2012 proposal for settlement (reattached to this email), and we look forward to PBMA's response to that settlement proposal in due course.

Regards,

Thomas.

-
--

Thomas Cook Intellectual Property Attorneys P.O. Box 1989, 3030 Bridgeway, Suite 425-430 Sausalito, California 94965-1989
Telephone: 415-339-8550

On 5/28/2013 3:41 PM, Leo Zucker wrote:

>
> Thomas,
>
> Per my e-mail of May 13, attached are PBMA's responses to 3D's First
> and Second Sets of Interrogatories and Document Requests, both of
> which were served on 3D by mail today with my attached cover letter.
>
> In view of 3D's pending motion to compel filed after my e-mail of May
> 13 below, and after PBMA's responses to both sets of 3D's requests for
> admissions were received by you, PBMA will neither agree nor offer any counterproposals to the items A. to
> D.
> suggested in your e-mail of May 6 at this time.
>
> Regards,
>
> Leo
>

> /Law Office of Leo Zucker /
>
> /Patent & Trademark Law /
>
> PO Box 1177
>
> Yorktown Heights, NY 10598
>
> Tel (914) 302-2460
>
> Fax (914) 302-2459
>
> /This e-mail and any attached files or items are proprietary and
> subject to attorney-client or work product privileges. The use or
> disclosure of this communication by anyone other than a designated
> addressee is unauthorized. If you are not an intended recipient,
> kindly notify the sender by reply e-mail, and destroy this
> communication and any copies thereof in your possession. /
>
> *From:* Leo Zucker [mailto:lzpatents@gmail.com]
> *Sent:* Monday, May 13, 2013 11:28 AM
> *To:* 'tom@thomascoklaw.com'
> *Subject:* 3D International LLC v. Palm Beach Motoring Accessories, Inc.
>
> Thomas,
>
> We are in the process of responding to 3D's outstanding discovery
> requests, and I will send PBMA's responses to you as each set is completed.
>
> I expect all of the responses will be completed and forwarded to you
> by the middle of next week, at which time we will also reply to the
> remaining items raised in your e-mail of May 6, below.
>
> Regards,
>
> Leo
>
> /Law Office of Leo Zucker /
>
> /Patent & Trademark Law /
>
> PO Box 1177
>
> Yorktown Heights, NY 10598
>
> Tel (914) 302-2460
>
> Fax (914) 302-2459
>
> /This e-mail and any attached files or items are proprietary and
> subject to attorney-client or work product privileges. The use or
> disclosure of this communication by anyone other than a designated
> addressee is unauthorized. If you are not an intended recipient,
> kindly notify the sender by reply e-mail, and destroy this
> communication and any copies thereof in your possession. /
>

EXH. J 2/2